

**PATENT**

## **REMARKS**

Applicants previously presented claims 1-32, 34-35 and 37-39 for examination. In the above-identified Office Action, all of the claims were rejected.

Applicants appreciate the comments and suggestions provided by both the Examiner and her Supervisor for the above-identified application. For the reasons to be stated below, Applicants respectfully traverse the Examiner's prior rejections.

By this amendment, Applicants have amended independent claims 1, 15, 23, 29 and 34. The limitations added into the above independent claims correspond to limitations previously appearing in now cancelled claim 11. Further support for the change can be found, for example, on page 8, lines 2-6, of the specification.

Applicants respectfully request that the Examiner reconsider the application in light of the amendments and the remarks expressed herein.

### **103 Rejections**

Claims 1-32 and 34-35 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2004/0236635 to Publicover (hereinafter referred to as "Publicover") in view of U.S. Patent No. 6,463,345 to Peachey-Kountz et al. (hereinafter referred to as "Peachey") and further in view of U.S. Patent No. 5,592,378 to Cameron et al. (hereinafter referred to as "Cameron"). Applicants respectfully disagree.

#### **Publicover**

Publicover pertains to a distribution system to distribute items to individuals. Publicover teaches (a) receiving an order from an individual, who places the order using different types of communication means, such as telephone, e-mail or regular mail,<sup>1</sup> (b) generating an order packet corresponding to the order, (c) shipping items in the order to a consolidating distribution center (CDC), where the items are packaged for the individual, and (d) transporting the package to a substantially unattended exchange site (DS) from which the individual can retrieve the package.<sup>2</sup>

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<sup>1</sup> Paragraph 25 of Publicover.

<sup>2</sup> Paragraph 7 of Publicover.

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No teaching or suggestions of considering another customer order and image viewing

Applicants agree with the Office Action that there is no teaching in Publicover regarding, for example, (a) considering another customer order to determine inventory oversold before the delivery of at least one item in the customer order, and (b) the customer allowed to view the image of at least one item to support the customer in placing the order.<sup>3</sup>

Substitution preference cannot be changed during the order

Regarding substitution, when an individual places an order in Publicover, a packet is generated and "cannot be changed" except as predetermined by the individual.<sup>4</sup> The predetermined part in Publicover seems to be based on a customer profile. It is not clear whether the customer profile can be changed, or when the customer profile can be changed. In any event, Publicover does not teach or suggest that a customer can change a substitution preference during an order.

No teachings or suggestions of a ratio rule in substitution

Applicants agree with the Office Action that there is no teaching in Publicover regarding any ratio rule for substituting the substitute item for the identified ordered item, let alone the quantity of the substitute item to be substituted for a quantity of the identified ordered item not being one for one, and being dependent on applying a ratio rule to the quantity of the identified ordered item.

To remedy the numerous deficiencies, the Office Action introduces Peachey.

Peachey

Peachey pertains to determining for a user the number of parts available to promise, such as in the semiconductor industry.

<sup>3</sup> The full paragraph on page 3 of the Office Action.

<sup>4</sup> Paragraph 75 of Publicover.

**PATENT****No Teaching or Suggestion of On-line Shopping in Peachey –  
Nonanalogous Art**

Peachey is a nonanalogous art of Applicants' claimed invention because Peachey is neither in the field of the Applicants' endeavor, nor is reasonably pertinent to the problem with which Applicants' invention was concerned.

Peachey pertains to assisting a user to determine the number of parts (such as semiconductor parts) available to promise to be sold. Applicants' claimed invention pertains to on-line shopping for customers. The two areas are distinct and different.

The Office Action argued that Applicants failed to prove that Peachey is nonanalogous art because "a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art."<sup>5</sup>

Applicants would like to point out to the Patent Office that between Peachey and Applicants' claimed invention, there are structural differences due to Peachey being a nonanalogous art.

For example, to facilitate on-line shopping, Applicants' claimed invention includes a mechanism to allow a customer to view the image of at least one item through a computing device. Peachey does not teach or suggest such features because Peachey's products and processes are not for on-line shopping.

First, in Peachey, the user of its system is the user of the tool to determine how many parts are available to promise. The tool is not for a customer placing an order on-line. Second, Peachey revolves around "parts", particularly parts in the semiconductor industries. A user in Peachey does not need to see how a part (such as a transistor) looks like before determining how many parts (such as transistors) are available to promise. Not surprisingly, Peachey does not teach or suggest allowing a user of its tools to view the image of an item through a computing device.

However, Applicants' invention pertains to a customer buying a product on-line. Such a customer probably would like to look at an image of the product, such as a bottle of shampoo, before buying it.

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<sup>5</sup> The last paragraph on page 12 of the Office Action.

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The nonanalogous art aspects between Applicants' claimed invention and Peachey lead to such structural differences. And nonanalogous art cannot be used to establish obviousness.

Peachey does not Teach or Suggest

(a) Keeping a Record of a Customer Substitution Preference

(b) Allowing a Customer to Modify a Preference During an Order or

(c) Deciding What to Substitute Based on Information Regarding the Customer's Substitution Preference

Again because Peachey is nonanalogous art, Peachey does not teach or suggest keeping a record of customer substitution preference or making use of it. Peachey's system does not pertain to a customer placing orders on-line. Peachey's system is for a user to decide the number of parts available to promise.

In Peachey, substitution could be done as determined by the user of the tool. If "equivalent parts may be substituted at appropriate times," the tool "automatically makes such substitutions directed by user based business decisions and in user defined time-periods."<sup>6</sup> Also, rules "of substitutions and alternate processes can be user-specified and varied over time to handle day-to-day decision making."<sup>7</sup> Here, the user is the user of the tool to determine the number of parts available to promise. The user in Peachey is not a customer placing an order.

Therefore, in distinct contrast to Applicants' claimed invention, Peachey does not teach or suggest keeping any record of a customer's substitution preference, or allowing a customer to modify a preference during an order, let alone deciding what to substitute based on information regarding the customer's substitution preference.

Peachey does not teach or suggest any ratio rule in substitution

Peachey does not teach or suggest any automatic substitution that depends on a ratio rule for substituting the substitute item for the identified ordered item, let alone the quantity of the substitute item to be substituted for a quantity of the identified ordered item not being one for one, and being dependent on applying a ratio rule to the quantity of the identified ordered item.

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<sup>6</sup> Col. 10, lines 3-7 in Peachey.

<sup>7</sup> Col. 5, line 66 to col. 6, line 3 in Peachey.

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The Office Action asserted that Peachey teaches such a ratio rule, and cited Peachey's col. 4, lines 45-67, as support for its position.<sup>8</sup>

However, that section of Peachey is an example of allocating different pieces to two different types of customers (tier 1 customers and lower tier customers). In that section, Peachey describes the day-by-day output of 100 pieces to be allocated to customers of different tiers. After the allocation, whatever remains would be available for new requests.

In any event, Peachey focuses on parts, such as semiconductor parts. Peachey teaches substitution for equivalent parts.<sup>9</sup> For example, the equivalent part of a transistor from one company can be a transistor from a different company. Peachey does not teach or suggest using a ratio rule in substitutions. It is not even clear how one can possibly use a ratio rule in Peachey such that the quantity of the substitute item to be substituted for a quantity of the identified ordered item is not one for one, and is dependent on the ratio rule.

Cameron

As to Cameron, it pertains to an order entry system particularly for the telemarketing industry, to assist a user to enter a customer order.<sup>10</sup> The Office Action introduced Cameron as support for allowing a customer to view the images of the item. Even if that is true, with Publicover and Peachey not teaching or suggesting numerous features in Applicants' claimed invention, introducing Cameron cannot remedy the deficiencies.

Summary

Since Applicants' independent claims include limitations similar to those described above that Publicover, Peachey and Cameron do not teach or suggest, it is submitted that the three references, alone or in any combination, do not teach or suggest Applicants' independent claims 1, 15, 23, 29 and 34. Similarly, dependent claims 2-10, 12-14, 16-22, 24-28, 30-32, 35, and 37-39 depend from one of the independent claims 1,

<sup>8</sup> The second paragraph on page 6 of the Office Action.

<sup>9</sup> Col. 10, lines 4-7 in Peachey.

<sup>10</sup> Col. 1, lines 13-16 of Cameron.

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15, 23, 29 and 34 and are, therefore, also not taught or suggested by any of the references for at least the reasons noted above.

Additional limitations recited in the independent claims or the dependent claims are not further discussed as the above-discussed limitations are clearly sufficient to distinguish the claimed invention from the three references

With claims 1-10, 12-32, 34-35, and 37-39 being patentably distinct from the cited references, Applicants respectfully request that the Examiner withdraw the rejection of claims 1-10, 12-32, 34-35 and 37-39 under USC 103(a). Reconsideration of the application and an early Notice of Allowance are earnestly solicited.

In the event that the Examiner, upon reconsideration, determines that an action other than an allowance is appropriate, the Examiner is requested and authorized to telephone Applicants' representative below prior to taking such action, if the Examiner feels that such a telephone call will advance the prosecution of the present application.

Respectfully submitted,

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